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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,785	12/29/2000	John Nelson	41934/23838	4216

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EXAMINER

KAM, CHIH MIN

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/673,785	<b>Applicant(s)</b> NELSON ET AL.	
	<b>Examiner</b> Chih-Min Kam	<b>Art Unit</b> 1653	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 12-20 and 22-27 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☒ Claim(s) 1 and 3-8 is/are allowed.  
 6) ☒ Claim(s) 2, 9, 10, 12-20 and 22-27 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Status of the Claims***

1. Claims 1-10, 12-20 and 22-27 are pending.

Applicants' amendment filed October 22, 2004 is acknowledged, and applicants' response has been fully considered. Claim 1-6, 9, 10, 12-17, 19, 20 and 22-25 have been amended, and claim 21 has been cancelled. Therefore, claims 1-10, 12-20 and 22-27 are examined.

**Rejection Withdrawn**

***Claim Rejections - 35 USC § 101***

2. The previous rejection of claims 1-4, 9, 10 and 19-23 under 35 U.S.C.101, is withdrawn in view of applicants' amendment to the claim, applicants' cancellation of the claim, and applicants' response at pages 9-10 in the amendment filed October 22, 2004.

***Claim Rejections - 35 USC § 112***

3. The previous rejection of claims 1-10 and 12-27, under 35 U.S.C.112, first paragraph, is withdrawn in view of applicants' amendment to the claim, applicants' cancellation of the claim, and applicants' response at pages 12-14 in the amendment filed October 22, 2004.
4. The previous rejection of claims 1-10 and 12-27, under 35 U.S.C.112, second paragraph, is withdrawn in view of applicants' amendment to the claim, applicants' cancellation of the claim, and applicants' response at page 14 in the amendment filed October 22, 2004.

**Claim Objections**

5. Claims 19, 20 and 22-27 are objected to because of the use of the term “ $\alpha\alpha$ -dialkyl substituted amino acid”, which should be “ $\alpha,\alpha$ -dialkyl substituted amino acid”. Appropriate corrections are required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 9, 10, 12-20 and 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 2, 9, 10, 12-20 and 22-27 are indefinite because the claims recite “the synthetic peptide factor having an N-terminal amino acid residue and a C-terminal amino acid residue”, and it also indicates the N-terminal amino acid residue, the C-terminal amino acid residue, and the cysteine residue of murine epidermal growth factor, it is not clear which peptide (the synthetic peptide factor or murine epidermal growth factor) the N-terminal amino acid residue, the C-terminal amino acid residue, and the cysteine residue refer to since the peptide factor, which comprises amino acid residues 33 to 42 of murine epidermal growth factor, is different from the murine epidermal growth factor. Claims 9, 10, 13, 14, 16-18, 22, 23, 26 and 27 are included in this rejection for being dependent on a rejected claim and not correcting the deficiency of the claim from which they depend.

***Conclusions***

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8. Claims 2, 9, 10, 12-20 and 22-27 are rejected, and it appears that claims 1 and 3-8 are free of art and allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.  
Patent Examiner



CMK  
January 11, 2005